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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,412	03/30/2001	Eleanor S. Wilson	85SF-00110	3204

23465 7590 03/20/2007  
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EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/681,412	<b>Applicant(s)</b> WILSON ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 45-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-20 and 45-53 are pending. Claims 1-5, 8, 11-15, and 45-49 have been amended in this communication filed 12/15/06 entered as Response After Non-Final Action and Request for Extension of Time.

#### ***Drawings***

2. The drawings are objected to because Figures 1-18 have font that is difficult to read the text in the drawing figures. Figure 3 contains shading which is too dark and need to be removed. Figures 5-15, 17, and 18 have a similar problem. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The Specification is objected to because Page 4, section [0028], line 3 recites "determining whether financing is pursued (Figures 5 18). Although specific". This line would be better recited "determining whether financing is pursued (Figures 5 and 18). Although specific". Page 8, line 4 recites "are U.S. taxes currently being paid by the customer, is the customer interested in". This line would be better recited as "are taxes in the United States currently being paid by the customer, is the customer interested in". Page 8, section [0041], line 5 contains the acronyms "EBITDA" and "pre-IPO". It is unclear what these acronyms stand for. Also, this section and line recite after "pre-IPO" "energy technology/services". Does Applicant mean "energy technology and services"? Correction is required. See MPEP § 608.01(b).

***Claim Objections***

4. Claims 1, 9, 11, 19, 45, and 52 are objected to because of the following informalities: Claim 1, the last claim limitation beginning with "include financing project, high yield debt, leasing, common project equity, limited partnership, private equity and preferred equity". This line would be better recited as "include a financing project, a high yield debt, leasing, a common project equity, a limited partnership, a private equity and a preferred equity". Claims 11 and 45 have a similar problem. Claim 9, line 4 recites "operating asset, are U.S. taxes currently being paid by the customer, is the customer". This line would be better recited as "operating asset, are taxes in the United States currently being paid by the customer, is the customer". Claims 19 and 52 have a similar problem. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 10-13, 45-47, and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11, and 45 contain a clause of intended use in the independent claims which renders the claims indefinite. Specifically, claim 1, lines 5 and 11 recites "being sought, wherein the energy-related asset ...; ...; ... to be used by the customer for financing the energy-related asset, wherein the financing types".

The Examiner considers these limitations to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "wherein" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

Claims 11 and 45 have a similar problem with "wherein" clauses.

Claim 2 is unclear and vague in the recitation "displaying a s computer generated screen listing the financing types: enabling the customer to ...". This claim is unclear and vague because the reader is expecting to read a listing of the financing types prior to the enabling a customer to select a financing type to be evaluated by the computer;". Claim 12 and 46 has a similar problem.

Claim 3 contains a conditional statement and it is unclear what happens if accessing an equity valuation tool if the customer does not input project common equity as the ...;". Claims 13 and 47 have a similar problem.

Claim 10, line 5 recites "financing, early stage pre-IPO company or company in early stage of corporate cycle and". This line contains an acronym and it is unclear what the acronym stands for. Claims 20 and 53 have a similar problem.

Claims 2-10, 12-20, and 46-53 are also rejected because they depend from a rejected base claim.

### **Inquiries**


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 14, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER